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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,152	09/24/2003	Federico J. Benetti	GUID-008CON2	2852

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LAW OFFICE OF ALAN W. CANNON
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EXAMINER	
PHILOGENE, PEDRO	
ART UNIT	PAPER NUMBER
3733	
MAIL DATE	DELIVERY MODE
03/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/670,152	BENETTI ET AL.	
	Examiner	Art Unit	
	Pedro Philogene	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-38 and 40-54* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-38 and 40-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13,24-28,31-34,36-38, 40-54 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,8-20 of U.S. Patent No. 6,199,556 in view of Deckman et al (5,984,867).

With respect to the above claims, it is noted that the patent claims disclose all the limitation, except for the main body or retractor remains resting against the frontal body of the patient; as claimed by applicant in the claims. However, in a similar art, Deckman et al evidences the use of a surgical retractor having a main body or retractor that remain resting against the frontal body of the patient so as to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

Therefore, given the teaching of Deckman et al, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device '556 as taught by Deckman et al., to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

Claims 13,24-28,31-34,36-38, 40-54 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,736,774 in view of Deckman et al. (5,984,867).

With respect to the above claims, it is noted that the patent claims disclose all the limitation, except for the main body or retractor remains resting against the frontal body of the patient; as claimed by applicant in the claims. However, in a similar art, Deckman et al evidences the use of a surgical retractor having a main body or retractor that remains resting against the frontal body of the patient so as to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

Therefore, given the teaching of Deckman et al., it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device '556 as taught by Deckman et al., to help elevate one side of the retractor body thereby lifting at least a portion of the ribs of the patient.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13-28,31-38,40-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Deckman et al. (5,984,867).

With respect to the claims, Deckman et al disclose a surgical apparatus for accessing a beating heart, the apparatus comprising a main body (22,102) configured to rest against the frontal body of a patient; and a lifting arm (40) rotatably mounted to the main body, as set forth in column 4, lines 46-50, and adapted to (or capable to) engage and lift at least a portion of the ribs of the patient, relative to reminder of the patient's body below the rib cage, while the body remains resting against the frontal body of the patient, when the patient is positioned horizontally; as best seen in FIG.12; a retractor arm (30) mounted to the main body and adapted to engage and spread a portion of the ribs with respect to the remainder of the ribs, in a direction different from a direction of the lifting, wherein the retractor arm comprises a hinge (60,80) to enhance positioning of a distal end of the retractor arm to engage the ribs; as set forth in column 4, lines 10-50, column 5, lines 33-67, column 6, lines 1-35; wherein the retractor arm is rotatably mounted to the body; as set forth in column 4, lines 25-28, the apparatus comprising two contact points, and wherein the lifting arm is mounted to the body at a location intermediate of he two contact points; (two contacts points at 34 and 102 and lifting arm mounted therebetween in FIG.6); three contacts points (at fig.6, the retractor 30, the foot plate 102, and the lifting arm 40), the retractor arm (30) mounted to the main body and adapted to engage and spread a portion of the ribs with respect to the remainder of the ribs, in direction different from a direction of the lifting; a first driving mechanism (74) for driving the lifting arm with respect to the body to perform lifting , and a second driving mechanism (130) for driving the retractor arm with respect to the body to perform the spreading; a beating heart stabilizer mounted on the body, as best seen in FIG.9,

and as set forth in column 8, lines 57-67, column 9, lines 24-44, an organ or tissue positioner (234a) fixed to the body; as set forth in column 9, lines 29-30; a light mounted to the apparatus; as set forth in column 9, lines 59-65; a locking mechanism (82) to fix the position of the means (40) for vertically offsetting in a vertically offset configuration, wherein the vertically offsetting means is a retractor (40) having a lifting arm operatively attached to a retractor frame.

With respect to the method claims, the method steps, as set forth, would have been inherently carried out in the operation of the device, as set forth above, such as making an incision, contacting tissue, contacting tissue on one side of the incision with first portion of a retractor (30), while contacting tissue on an opposite side of the incision with a second portion of the retractor (40); and moving the second portion of the retractor in direction substantially perpendicular to a horizontal orientation of the remainder of the retractor, thereby vertically offsetting at least a portion of the rib cage; as best seen in FIG.6

With regard to the recitation that an element is "adapted to" or "configured to" it is noted that it has been held that the recitation that an element is "adapted to" or "configured to" perform a function is not a positive limitation but requires the ability to so perform. It does not constitute a limitation in any patentable sense. In addition, the manner in which a device is intended to be employed, does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1887).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 29,30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deckman et al. (5,984,867) in view of Asrican (3,680,546).

With respect to the above claims, it is noted that Deckman did not teach of fiber optic light; as claimed by applicant. However, in a similar art, Asrican evidences the use of fiber optic light to serve to direct the direction of light in the chest cavity.

Therefore, given the teaching of Asrican, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Deckman et al., as taught by Asrican, to serve to direct the direction of light in the chest cavity.

Response to Amendment

Applicant's arguments filed 11/29/07 have been fully considered but they are not persuasive. First, applicant's remark with respect to the Terminal Disclaimer is noted. Second, applicant stated that if the examiner intends to maintain his position, the examiner is respectfully requested to specifically identify where each and every interpretation of Deckmann et al is disclosed. The examiner believes that each and every limitation of the claims has been shown in the action herein above. Applicant's attention is specifically directed to column 3, lines 22-25, lines 52-67, column 4, lines 10, lines 25-28, 37, 45-50, 65-67, column 5, lines 1-21, column 6, lines 35-65, column 9,

lines 24-65, column 10, lines 39-67, column 11, lines 1-67. As to the functional language, if the device of Deckmann et al is capable of performing the function, as claimed, it meets the claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/
Primary Examiner, Art Unit 3733
February 29, 2008